

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/549,290

Applicant(s)

HATANO ET AL.

Examiner

KALLAMBELLA
VIJAYAKUMAR

Art Unit

1793

—The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

THE REPLY FILED 21 May 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:
a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
b) ☐ They raise the issue of new matter (see NOTE below);
c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 2-11.
Claim(s) objected to: _____.
Claim(s) rejected: 12.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: PTO-892 Attached.

/Stanley Silverman/
Supervisory Patent Examiner, Art Unit 1793

Continuation of 11. does NOT place the application in condition for allowance because:

Applicants arguments filed 05/21/2008 have been fully considered and fail to overcome the rejection of claim-12 for the following reasons: In response to the high ionic conductivity over a wide range of temperature and small crystallite sizes (Res, Pg-3, Para-2 and 3), they are not the limitations of the instant claim-12, and although "That claims are interpreted in light of the specification does not mean that everything in the specification must be read into the claims." *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957, 220 USPQ 592, 597 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984).

In response to Badwal does not teach or suggest the instant claimed structure, influence of the β -phase on the claimed structure, of minimizing the crystallite size, and effectively omitting the β -phase (Pg-3, Para-3), Badwal teaches ion-conducting single phase cubic SCZ (Sc_2O_3 : 9.0, 9.3, 9.5 mol%) compositions that meets the ratio limitations/structure in the claim-12 (Pg-93, Results and discussion), because the instant claimed limitation of I-cubic/(I-cubic + I-beta) $\geq 90\%$ includes the range 90-100% cubic i.e. elimination of beta phase as argued by the applicants. Crystallite size or minimizing it is not the limitation of the instant claim-12.

The same argument applies to Tanaka Reference (Res, Pg-4, Para-1) and the < 5 mol% monoclinic phase (x) in Tanaka encompasses a range $0 < x < 5$ mol% that is not excluded by the instant claim limitation of "comprising".

With respect to unexpected results (Res, Pg-3, Para-2), the data in Tables 1 and 4 does not cover the instant claimed range, and it is not commensurate in scope to show that the instant claimed composition produced by a specific method steps is materially different than the prior art compositions which are encompassed by the instant claim limitation. Furthermore, the scandia-zirconia compositions that are either same or substantially same as in instant claim-12 have cubic crystalline structure and high ionic conductivity as shown by Ishi wt al (JP 05-225820; Abstract; IDS 06/16/2005; Also see Ukai, US 6,787,261, Cl-7, Tbl-1; Ukai: US 7,108,938, Cl-16, Tbl-2).

For the reasons set forth above applicants fail to patentably distinguish their product by process composition over the prior art.

/KMV/

May 30, 2008.